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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/260,802	03/02/1999	STEVEN M. HOFFBERG	3459-11	6940

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EXAMINER

GORDON, PAUL P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 11/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/260,802

Applicant(s)

Hoffberg et al.

Examiner

Gordon

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 29, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-112 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-11, 14, drawn to a programmable apparatus and interface for receiving instructions from a user and causing an action to occur on an event, classified in class 700, subclass 83.

II. Claim 12, drawn to a videotape recording apparatus for analyzing a video signal for a symbol, classified in class 725, subclass 9.

III. Claim 13, drawn to a recording device for recording an analog signal on a medium and means for characterizing the address of the signal, classified in class 369, subclass 47.

IV. Claims 25-26, drawn to an adaptively controlled plant, classified in class 700, subclass 45.

V. Claims 27-34, drawn to a method and apparatus for recognizing images via template matching, classified in class 382, subclass 209.

VI. Claims 35-65, drawn to system and method for automatically accessing information by presenting items of user interest and/or updating a user profile of interest, classified in class 707, subclass 2.

VII. Claims 15-24, 66-100, drawn to a system and method for selecting programs based on subscriber(preferences) and program control data, classified in class 725, subclass 46.

VIII. Claims 101-107, drawn to a method for controlling and analyzing a plural channeled signal by decoding textual signal data for tuning purposes, classified in class 725, subclass 38.

IX. Claims 108-112, drawn to a method for classifying an input pattern from an

acquired signal using wave transforms, classified in class 342, subclass 90.

2. The inventions are distinct, each from the other because of the following reasons:

Invention I is distinct from the other inventions because it is the only invention related to a user programmable interface.

Invention II is distinct from the other inventions because it is the only claim used for videotape recording.

Invention III is distinct because it is the only claim concerning the storage of an analog signal and its characterization in separate storage locations.

Invention IV is distinct because no other invention group adaptively controls a plant.

Invention V is distinct because it is the only invention which recognizes patterns images using templates.

Invention VI is distinct because it is the only invention querying a user with items of interest and updating the user's profile based on their selections.

Invention VII is distinct because it is the only invention for selecting programming based on subscriber preference and control input.

Invention VIII is distinct because it is the only invention for analyzing a plural channeled signal using a decoding schema.

Invention IX is distinct because it is the only invention that classifies patterns using waveform analysis.

3. Because these inventions are distinct for the reasons given above and have separate status in the art as shown by their different classifications, and have separate status and different searches in the art because of their divergent subject matter, and would further require considerations of substantially different issues during prosecution restriction for examination purposes as indicated is deemed proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(h).

6. It is noted the preliminary amendment filed March 2, 1999 could not be entered in its entirety. On page 45, the request for claims 50-57, 60-65, 68-91, and 95-100 to be canceled was not entered because it did not comply with 37 C.F.R. §1.121.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Gordon whose telephone number is (703) 305-9760. The examiner can normally be reached on Mondays through Thursdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant, can be reached on (703) 308-1108. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


PAUL P. GORDON
PRIMARY EXAMINER

ppg
November 13, 2001